



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FISH & NEAVE
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK NY, 10020-1105

COPY MAILED

AUG 06 2004

OFFICE OF PETITIONS

In re Application of :
Richard M. Weiss, **Joseph H. Butler**, :
Michael J. Twigg, F. Sherrill : DECISION REFUSING STATUS
Vowell and Larry R. Palmer : UNDER 37 CFR 1.47(a)
Application No. 10/037,701 :
Filed: November 9, 2001
For: METHOD AND APPARATUS FOR
MEASURING AND ORIENTING GOLF CLUB
SHAFT

This is in response to the "Petition Under 37 CFR 1.47(a)," filed September 18, 2002, regarding non-signing inventor **Joseph H. Butler**. The petition was recently forwarded to this office for review.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on November 9, 2001 without an executed oath or declaration and naming Richard M. Weiss, **Joseph H. Butler**, Michael J. Twigg, F. Sherrill Vowell and Larry R. Palmer as joint inventors.

Accordingly, on March 22, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

In response, on September 18, 2002, the instant petition and a four (4) month extension of time were filed.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee; and
- (4) a statement of the last known address of the non-signing inventor.

Applicant lacks items (1), (2) and (4), as set forth above.

As to item (1), applicant appears to demonstrate that a bona fide attempt was made to present non-signing inventor **Joseph H. Butler** (via Mr. Butler's attorney, H. Leo Beale) with only the Declaration and Power of Attorney and Assignment. However, applicant has not demonstrated that a bona fide attempt has been made to present non-signing inventor **Joseph H. Butler** with a copy of the application papers (specification, claims and drawings). Unless non-signing inventor **Joseph H. Butler** was presented with a copy of the application papers (specification, claims and drawings), non-signing inventor **Joseph H. Butler** could not attest that he has "reviewed and understands the application papers" and therefore could not sign the declaration which he was given. Accordingly, Rule 47 applicant failed to show or provide proof that the inventor has refused to sign the declaration. See MPEP, Section 409.03(d). Petitioner should show that a copy of the application papers was presented (or a bona fide attempt made to present) to the non-signing inventor, but that the non-signing did not respond to, or refused, the request that he sign the oath/declaration in order to show that the non-signing inventor has refused to join in the application. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The signature blocks of the non-signing inventors have

been executed by inventor Richard M. Weiss. However, the signature blocks of the non-signing inventors must be executed by all of the signing joint-inventors, or left blank. See MPEP 409.03(a).

As to item (4), a statement of the inventor's last known address is missing and is required. See MPEP 409.03(e).


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 Box 1450
 Alexandria, VA 22313

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 2011 South Clark Place
 Crystal Plaza Two (left side entrance of building)
 Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703)306-9200.

A handwritten signature in dark ink, appearing to read 'Edward J. Tannouse', with a long horizontal flourish extending to the right.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office